

REMARKS

Claims 1 – 7, 9 – 18 and 20 - 27 are pending in this application.

Applicant, applicant's representation Dexter Chang, Reg. No. 44,071, and the Examiner conducted a telephone interview on July 29, 2005. Applicant and Mr. Chang thank the Examiner for his time in participating in this interview.

35 U.S.C. § 132(a) Objection to the Specification

The Examiner objected to the amendments to the specification in applicant's January 18, 2005 response under 35 U.S.C. § 132(a) for allegedly introducing new matter. Applicant respectfully traverses the Examiner's objection.

The Examiner objected to applicants correction of Figs. 4a-4d and their corresponding description on pages 12-15 of the specification. Specifically, the Examiner asserted that "a list of operators [being] updated after a selection of an initial item entry" is new matter not supported by the original disclosure, and that the original disclosure only supported "updating the list of operators after a second term is selected, wherein the second item is selected after the initial item and an operator are selected." Page 2, lines 12-13 of the Office Action.

An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction. *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

The Examiner has acknowledged that the original disclosure provides for "updating" the list of operators in response to a user's selection. Applicant respectfully submits that one skilled in the art would ascertain that "updating" a user's choices, including a list of operators, in response to a user's selection of an entry item is adequately described in the original disclosure—see, e.g., Fig. 6 and the corresponding description of the specification—such that it would be inconsistent not to update the list of operators after a user selects an item. Applicant

realized that the illustrative embodiment described in Figs. 4a-4d contained an inconsistency in demonstrating this feature of the claimed invention and amended the specification and figures in a good faith effort to clarify the claimed invention. It is respectfully submitted that one skilled in the art would recognize this inconsistency and the appropriate correction made by the applicant in the above January 18, 2005 Response.

M.P.E.P. 2163.07(a) Inherent Function, Theory, or Advantage

"By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 43 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F 3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)."

As discussed above and acknowledged by the Examiner, the original disclosure clearly describes updating the operator list in response to a user's entry. The fact that a separate user entry and an operator is selected prior does not alter the fact that the list of operators is "updated" in response to a user selecting an entry. The entire original disclosure consistently describes the "updating" of choices—entries and operators—such that choices that would yield a null result are eliminated. Thus, it is an inherent feature to update a list of operators after a user selects an initial item. Applicant respectfully submits that it would be obvious to one skilled in the art to modify the example shown in Figs. 4a-4d in the manner proposed in the January 18, 2005 Response to properly illustrate this inherent feature. Accordingly, the inherent feature of "updating" the list of operators in response to an initial item is wholly consistent and supported in the original disclosure.

In fact, the Examiner, in his § 103 prior art rejection discussed below, cited U.S. Patent No. 5,963,938 to Wilson et al. as describing "undating (logical) operators to limited possible

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